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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/316,938 | 05/21/1999 | MICHAEL THORSEN | 1685 | 8498 |
| 21834 | 7590 | 04/04/2005 | EXAMINER | |
| BECK AND TYSVER 2900 THOMAS AVENUE SOUTH SUITE 100 MINNEAPOLIS, MN 55416 | | | RIMELL, SAMUEL G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2165 | |

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/316,938 | Applicant(s) THORSEN ET AL. | |
| | Examiner Sam Rimell | Art Unit 2165 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman Jr. et al. (U.S. Pat. 6,012,035) in view of Tarter et al. (U.S. Patent 5,550,734).

Claim 19: Freeman Jr. et al. discloses a system in which multiple providers (physicians) provide medical services to multiple patients. The providers report the services they rendered to a first entity, which is the insurance company of Freeman, Jr. et al. (col. 2, line 14; col 2, lines 41-43).

Freeman Jr. et al. differs from the claims in that it does not disclose the first entity (insurance company) reporting to a sponsor. However, Tarter et al. at col. 4, lines 36-44 describes a sponsor in the form of an employer (a commercial bank) which sponsors an insurance plan for its employees, establishes the insurance policy and pays the premiums for the policy. The entity would thus report to the sponsor on a periodic basis indicating the aggregate amount owed by the sponsor (premiums due) for the services rendered by the entity (insurance coverage). The insurance plan is "self funded by the sponsor" in the sense that the sponsor pays the funds for the premiums due. It would have been obvious to one of ordinary skill in the art to modify Freeman Jr. et al. to include an employer as a sponsor of the described insurance plan as an efficient design for group health insurance coverage as taught by Tarter et al.

The entity (insurance company) reports to the patient on a periodic basis of the amount owed by the patient for provider services not covered by the insurance (col. 8, lines 30-35 of Freeman Jr. et al.).

The entity (insurance company) collects payments from the sponsor (employer) in the form of insurance premiums.

The entity (insurance company) pays the provider for the services rendered regardless of any payments by the patient to the entity. This is because the entity is an insurance company making insurance payments on the basis of an insurance contract established and paid for by an employer.

Additional payments may be collected from the patient for the patient's share of uncovered claims (col. 8, lines 33-36 of Freeman Jr. et al.).

Claim 20: The entity collects a lump sum payment from the sponsor in the form of insurance premiums.

Claim 21: See remarks for claim 19.

Claim 22: The "explanation of benefits" sent to the patient and described at col. 8, line 32 of Freeman et al. reads as the "plain language description of services rendered".

Claim 23: See remarks for claim 19. The "administrator" is equivalent to the "entity" of claim 19 and reads as the insurance company of Freeman, Jr. et al. The combination of Freeman Jr. et al. and Tartar et al. teach that the statements are submitted to the patient by the "administrator" or "entity" and not from the sponsor (the employer) or the health care provider.

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Remarks

Applicant's response is primarily addressed to the affidavit of Nazie Eftekhari, submitted December 30, 2004. Although not stated within the content of the affidavit, this submission is presumed to have been submitted under 37 CFR 1.132 and has been fully considered.

The affidavit is not effective in overcoming the rejection under 35 USC 103 for the following reasons:

(1) Affidavits submitted under 37 CFR 1.132 may be used to address the issue of obviousness. The issue of obviousness in this case is whether or not it would have been obvious for an employer to sponsor an insurance plan for its employees. The affidavit is addressed primarily to the applicant's system of business, where the employer receives a single unified billing statement for its employees health care services or costs. This information does not appear to be related to, or answer the question of whether a person of ordinary skill in the art would recognize the existence of or advantages of employer sponsorship of health care plans. Instead, the affidavit is directed to applying unified billing statements to employers who are already sponsoring health plans for employees.

(2) The affidavit is not specifically directed to the subject matter of the claims, but is directed instead to the entire application.

(3) There is no documentary evidence supporting the revenue figures.

(4) There is no evidence that the revenue figures are exclusively attributable to the invention (as stated on page 1).

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(5) There is no documentary evidence illustrating the sales figures in comparison to market share.

(6) There is no documentary evidence of long felt need for the invention by persons of ordinary skill in the art.

(7) There is no documentary evidence that the long felt need was unsolved by others of evidence of prior unsuccessful attempts to solve the same problem.

In view of the these deficiencies, the affidavit is not considered effective in overcoming the rejection under 35 USC 103.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'Sam Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
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